REMARKS

The Official Action dated February 23, 2006 has been carefully considered. It is believed that the present Amendment places the present application in condition for allowance. Reconsideration is respectfully requested.

Initially, the undersigned acknowledges with appreciation the telephone interview of July 20, 2006 which the Examiner granted. During the interview, the amendments set forth herein were discussed and particularly the amendment of claim 29 to recite that the radiation cured encapsulating material has a Young's modulus at 25° C in the range of from about 3,000 to about 15,000 psi. The undersigned also discussed the distinctions between the claimed radiation cured encapsulating material and the teachings of the Szum U.S. Patent No. 6,240,230, as will be discussed in further detail below. Although a formal agreement was not reached during the telephone interview, the Examiner indicated that further consideration would be given to the amendments and arguments set forth herein.

By the present Amendment, claim 29 is amended to include the limitation from previous claim 48 that the material has a modulus at 25° C in the range of from about 3,000 to about 15,000 psi. Since this limitation was previously presented in claim 48, it is not believed to raise any new issues subsequent to final rejection. Moreover, as discussed during the interview, claim 29 specifies that the modulus is the Young's modulus. As the specification defines modulus as the Young's modulus (see, for example, page 11, lines 8-15), recitation of the modulus in claim 29 as the Young's modulus does not raise any new issues subsequent to final rejection, but merely specifies an inherent limitation of the previous claims. Finally, claims 30-32, 47 and 48 are amended to delete the modulus limitations thereof in order to correspond with claim 29 as amended. As the claim amendments set forth herein do not involve any introduction of new matter and do not raise any new issues subsequent to final rejection, entry is believed to be in order and is respectfully requested.

Claims 29-52 were rejected under 35 U.S.C. §102(e) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over the Szum U.S. Patent No. 6,240,230. The Examiner has asserted that Szum sets forth compositions that are substantially the same as or similar to that contemplated by Applicants' claims, whereby the compositions taught by Szum necessarily result in the claimed tear strength and adhesion force. Additionally, the Examiner asserted that Szum teaches his composition can have a modulus within Applicants' claimed range, referring to column 7, lines 62-67 and column 13, line 66.

This rejection is traversed and reconsideration is respectfully requested. Applicants submit that the radiation cured encapsulating materials as defined by pending claims 29-40 and 44-50 are neither anticipated by nor rendered obvious over Szum.

More particularly, independent claim 29 recites a radiation cured encapsulating material having a tear resistance of less than about 2.20 pounds force, an adhesion force to an underlying surface material of greater than about 0.0044 pounds force and a Young's modulus at 25°C of from about 3000 to about 15,000 psi. As discussed during the aforementioned interview, the materials of the invention provide a good balance of competing properties so that the material exhibits good adhesion but can but torn in a predictable manner in the field.

Szum broadly discloses radiation curable compositions comprising 20 weight percent to about 80 weight percent of at least one urethane acrylate oligomer, about 20 weight percent to about 80 weight percent of at least one monomer diluent, and an effective amount of at least one photoinitiator. Szum specifically discloses that mechanical properties of the compositions and materials are effected by the selection of oligomer and by selection of reactive or monomer diluent (column 7, lines 1-3).

However, Szum provides no teaching or suggestion as to the tear resistance, adhesion force to an underlying surface material, or modulus required by claim 29. Particularly,

Applicants find no teaching by Szum relating to either tear resistance or adhesion force, and the modulus of the compositions taught by Szum is significantly distinguishable from that required by claim 29. While, as noted by the Examiner, Szum discloses at column 7, lines 64-67 that rubbery modulus values can be at least 8 MPa and preferably greater than about 15 MPa and more preferably greater than about 25 MPa, corresponding to 1160, 2175 and 3625 psi, one of ordinary skill in the art will recognize that the rubbery modulus is not the Young's modulus, which is a tensile modulus, as recited in claim 29. The only teaching which Applicants find by Szum relating to a tensile modulus is in Examples 1 and 3 wherein the exemplary compositions are disclosed as exhibiting a tensile modulus of 973 MPa and 740 MPa, corresponding to 140,000 psi and 107,000 psi, respectively. Similarly, at column 13, line 66, reference is merely made to a coating having a modulus less than about 2,000 psi. Again, Applicants find no teaching or suggestion by Szum relating to a Young's (tensile) modulus in the range of from 3,000 to 15,000 psi as required by claim 29. Thus, Szum fails to disclose materials exhibiting the combination of properties required by claim 29, including a Young's modulus of from about 3,000 to about 15,000 psi, and in fact discloses materials having a significantly different tensile modulus as compared with that required by claim 29.

The Examiner has asserted that a composition that is substantially the same as or similar to that contemplated by Applicants in claims 33-38 necessarily results in the requisite tear strength and adhesion force, whereby the compositions disclosed by Szum inherently exhibit the tear resistance and adhesion force recited in claim 29. However, rejection for anticipation or lack of novelty requires, as the first step in the inquiry, that all of the elements of the claimed invention be described in a single reference, and that the reference must describe the Applicants' claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it, *In re Spada*, 15 U.S.P.Q. 2d 1655, 1657. In this regard, a prior art disclosure of a generic composition encompassing a vast number of

compositions, including an Applicant's claimed compositions, does not by itself describe the Applicant's claimed compositions in the meaning of 35 U.S.C. §102; rather, such prior art reference must further provide a more specific limited teaching relating to the claimed compositions in order to anticipate the same, *In re Petering*, 133 U.S.P.Q. 275 (C.C.P.A. 1962); *In re Ruschig*, 145 U.S.P.Q. 274 (C.C.P.A. 1965); *In re Arkley*, 172 U.S.P.Q. 524 (C.C.P.A. 1972). In view of the failure of Szum to more specifically disclose a composition along the lines of those exemplified in the present application as exhibiting a tear resistance, an adhesion force and a Young's modulus as recited in claim 29, Szum does not disclose a composition which inherently exhibits the combination of properties presently claimed.

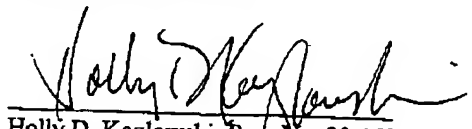
To the contrary, as discussed above, the exemplary teachings of Szum disclose compositions which are significantly distinguishable in terms of Young's modulus from those exemplified in the present application. While the teachings of a reference are not limited to examples, any assertion of inherency must surely be limited to the examples, as the broad teachings of Szum cannot support any anticipation rejection under 35 U.S.C. §102. Moreover, while independent claim 29 is not limited to the compositions of examples 1 and 2 set forth in the present specification, Applicants have presented these examples as exemplary of materials exhibiting the properties recited in claim 29, and the failure of Szum to teach such compositions demonstrates the failure of Szum to inherently disclose compositions exhibiting the combination of properties required by present claim 29

In order to render a claimed invention obvious, the prior art must enable one skilled in the art to make and use the claimed invention, *Motorola, Inc. v. InterDigital Tech. Corp.*, 43 U.S.P.Q.2d 1481, 1489 (Fed. Circ. 1997). In view of the deficiencies in the teachings of Szum discussed in detail above, Szum does not enable one skilled in the art to make and use a radiation cured encapsulating material having the combination of properties required by claim 29. Thus, Szum does not render the presently claimed materials obvious.

It is therefore submitted that the claimed radiation cured encapsulating materials are neither anticipated by nor rendered obvious over Szum, whereby the rejections under 35 U.S.C. §§102 or 103 have been overcome. Reconsideration is respectfully requested.

It is believed that the above represents a complete response to the rejections set forth in the Official Action, and places the present application in condition for allowance. Reconsideration and an early allowance are requested.

Respectfully submitted,



Holly D. Kozlowski, Reg. No. 30,468
DINSMORE & SHOHL LLP
1900 Chemed Center
255 E. Fifth Street
Cincinnati, Ohio 45202
(513) 977-8568

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